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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,837	11/28/2000	Mary L. Williamson	008.0170.01	6153

22895 7590 11/23/2005

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EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/724,837	WILLIAMSON ET AL.	
	Examiner	Art Unit	
	Brian Goddard	2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is responsive to the Amendment filed 24 August 2005.
2. Claims 1-34 are pending in this application. Claims 1, 9, 18, 25, 33 and 34 are independent claims. In the response filed 24 August 2005, no claims were amended, cancelled or added. This action is made Final.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-5, 8-13, 16-17, and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,692,206 issued to Shirley et al. (hereafter Shirley '206) in view of U.S. Patent No. 5,774,866 issued to Horwitz et al. (hereafter Horwitz '866).

Claim 1:

Regarding Claim 1, Shirley '206 discloses a means to generate legal documents. Specifically, Shirley '206 discloses: a system for facilitating complex document drafting (Shirley '206: col. 2, Ins. 8-10) and further discloses:

- a database comprising a table of individual clauses with each individual clause including provisions and terms relating to one or more potentially affected parties (Shirley '206: col. 5, Ins. 22-46).

However, Shirley '206 does not explicitly disclose authenticated clause selection.

Additionally, Shirley '206 does not explicitly disclose:

- a list of authorizations stored into the database with each authorization controlling clause modification and usage by users for each individual clause;
- a list of preferences stored into the database with each preference influencing clause selection for each individual party; and
- a clause selection module authenticating each selection of an individual clause from the individual clauses table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties.

Horwitz '866 discloses an organizational cross checking database for legal organizations. Specifically Horwitz '866 discloses authenticated clause selection (Horwitz '866: Abstract). Additionally, Horwitz '866 discloses:

- a list of authorizations stored into the database with each authorization controlling clause modification and usage by users for each individual clause (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person" – note connection to item 90 labeled "Matter");
- a list of preferences stored into the database with each preference influencing clause selection for each individual party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person" – note that restricting clauses and matters reads on a preference that influences selection); and
- a clause selection module authenticating each selection of an individual clause from the individual clauses table against the authorizations list for a given user

and the preferences list for the given user and the potentially affected parties (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43).

It would have been obvious to a person having ordinary skill in the art to apply the cross checking database of Horwitz '866 to the legal document generation means of Shirley '206 by creating an entry in the matter table of Horwitz '866 (Horwitz '866: Fig. 4A, item 90 labeled "Matter"). The motivation to combine is suggested by Horwitz '866 which discloses the advantage of being able to detect conflicts of interests in legal documents such as that of Shirley '206 (Horwitz '866: col. 2, ln. 61 to col. 3, ln. 18).

Claims 2-5 and 8:

Regarding Claims 2-5 and 8 Shirley '206 and Horwitz '866 in combination disclose all the limitations of Claim 1 (supra). Additionally, Shirley '206 and Horwitz '866 in combination disclose:

- (Claim 2) further comprising:
 - o an index indexing the individual clauses into a topical ordering based on the subject matter addressed therein (Horwitz '866: Fig. 4A, item 90, "Matter_ID" key field - note that as combined with Shirley '206, each matter corresponds to a clause, each of which has its own topic); and
 - o the clause selection module selecting each individual clause from the topical ordering (Horwitz '866: col. 2, ln. 61 to col. 3, ln. 18 – note application of rules).
- (Claim 3) further comprising:

- a table of annotations stored into the database with each annotation providing an explanatory description of at least one linked individual clause (Horwitz '866: Fig. 4A, item 110 labeled "Matter Notes"); and
 - the clause selection module presenting each annotation upon the selection of the at least one linked individual clause from the individual clauses table (Horwitz '866: col. 2, ln. 61 to col. 3, ln. 18 – note application of rules).
- (Claim 4) further comprising:
- a table of standard outlines stored into the database with each standard outline creating an organizational framework into which the individual clauses can be inserted in a structured order (Shirley '206: col. 2, lns. 10-18 - note standard contract documents read on standard outlines);
 - a list of authorizations stored into the database with each authorization controlling outline modification and usage by users for each standard outline (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person");
 - a list of preferences stored into the database with each preference influencing outline selection for each individual party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person"); and
 - a standard outline selection module authenticating each selection of a standard outline from the standard outlines table against the authorizations list for a given user and the preferences list for the one or more individual parties (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43).

- (Claim 5) further comprising:
 - o a table of non-standard outlines stored into the database with each nonstandard outline creating an organizational framework into which the individual clauses can be inserted (Shirley '206: col. 2, Ins. 10-18 - note user defined provisions create non-standard contract documents);
 - o a list of authorizations stored into the database with each authorization controlling outline modification and usage by users for each standard outline (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person");
 - o a non-standard outline selection module authenticating each selection of a non-standard outline from the non-standard outlines table against the authorizations list for a given user (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43).
- (Claim 8) wherein at least one of the list of authorizations and the list of preferences further comprises pricing information (Horwitz '866: Fig. 4B, items 94 and 96; col. 10, Ins. 52-63 - note that a billing relationship is explicitly stored and that billing information reads on pricing information), the system further comprising:
 - o the clause selection module filtering each selection of an individual clause from the individual clauses table against pricing information (Horwitz '866: col. 2, ln. 61 to col. 3, ln. 18 – note application of rules).

Claim 9:

Regarding Claim 9 Shirley '206 discloses a means to generate legal documents. Specifically, Shirley '206 discloses: a method for facilitating complex document drafting (Shirley '206: col. 2, Ins. 8-10) and further discloses:

- maintaining a database comprising a table of individual clauses with each individual clause including provisions and terms relating to one or more potentially affected parties (Shirley '206: col. 5, Ins. 22-46).

However, Shirley '206 does not explicitly disclose authenticated clause selection.

Additionally Shirley '206 does not explicitly disclose:

- storing a list of authorizations into the database with each authorization controlling clause modification and usage by users for each individual clause (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person" – note connection to item 90 labeled "Matter");
- storing a list of preferences into the database with each preference influencing clause selection for each individual party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person"); and
- authenticating each selection of an individual clause from the individual clauses table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties (Horwitz '866: col. 18, In. 63 to col. 19, In. 43).

Horwitz '866 discloses an organizational cross checking database for legal organizations. Specifically Horwitz '866 discloses authenticated clause selection (Horwitz '866: Abstract). Additionally, Horwitz '866 discloses:

It would have been obvious to a person having ordinary skill in the art to apply the cross checking database of Horwitz '866 to the legal document generation means of Shirley '206. The motivation to combine is on the same basis as Claim 1 (supra).

Claims 10-13 and 16-17:

Regarding Claims 10-13 and 16-17 Shirley '206 and Horwitz '866 in combination disclose all the limitations of Claim 9 (supra). Additionally, Shirley '206 and Horwitz '866 in combination disclose:

- (Claim 10) further comprising:
 - o indexing the individual clauses into a topical ordering based on the subject matter addressed therein (Horwitz '866: Fig. 4A, item 90, "Matter_ID" key field - note that as combined with Shirley '206, each matter corresponds to a clause, each of which has its own topic); and
 - o selecting each individual clause from the topical ordering (Horwitz '866: col. 2, ln. 61 to col. 3, ln. 18 – note application of rules).
- (Claim 11) further comprising:
 - o storing a table of annotations into the database with each annotation providing an explanatory description of at least one linked individual clause (Horwitz '866: Fig. 4A, item 110 labeled "Matter Notes"); and
 - o presenting each annotation upon the selection of the at least one linked individual clause from the individual clauses table (Horwitz '866: col. 2, ln. 61 to col. 3, ln. 18 – note application of rules).
- (Claim 12) further comprising:

- storing a table of standard outlines into the database with each standard outline creating an organizational framework into which the individual clauses can be inserted in a structured order (Shirley '206: col. 2, Ins. 10-18 - note standard contract documents read on standard outlines);
 - storing a list of authorizations into the database with each authorization controlling outline modification and usage by users for each standard outline (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person");
 - storing a list of preferences into the database with each preference influencing outline selection for each individual party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person"); and
 - authenticating each selection of a standard outline from the standard outlines table against the authorizations list for a given user and the preferences list for the one or more individual parties (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43).
- (Claim 13) further comprising:
- storing a table of non-standard outlines into the database with each nonstandard outline creating an organizational framework into which the individual clauses can be inserted (Shirley '206: col. 2, Ins. 10-18 - note user defined provisions create non-standard contract documents);
 - storing a list of authorizations into the database with each authorization controlling outline modification and usage by users for each standard outline (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person");

- o authenticating each selection of a non-standard outline from the nonstandard outlines table against the authorizations list for a given user (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43).
- (Claim 16) wherein at least one of the list of authorizations and the list of preferences further comprises pricing information (Horwitz '866: Fig. 4B, items 94 and 96; col. 10, lns. 52-63 - note that a billing relationship is explicitly stored and that billing information reads on pricing information), the system further comprising: the clause selection module filtering each selection of an individual clause from the individual clauses table against pricing information (Horwitz '866: col. 2, ln. 61 to col. 3, ln. 18 – note application of rules).
- (Claim 17) a computer-readable storage medium holding code for performing the method of Claim 9 (Horwitz '866: col. 25, ln. 60 to col. 26, ln. 24).

Claim 33:

Regarding Claim 33, Shirley '206 discloses a means to generate legal documents. Specifically, Shirley '206 discloses: an automated system for drafting a contract (Shirley '206: col. 2, lns. 8-10). Additionally, Shirley '206 discloses:

- a database shareable by a plurality of users, comprising:
 - o a table of contract clauses, each contract clause relating to one or more parties potentially affected by a use of the contract clause and including annotations explaining the content thereof (Shirley '206: col. 5, lns. 22-46);

- o a table of contract outlines, each outline creating an organizational framework into which the clauses can be inserted to form the contract and including annotations explaining the content thereof (Shirley '206: col. 2, Ins. 10-18);

However, Shirley '206 does not explicitly disclose: authenticated content selection.

Additionally, Shirley '206 does not explicitly disclose:

- a set of searchable indices of the contract clauses table and the contract outlines table using a topical ordering;
- a list of authorizations with each authorization controlling contract clause and contract outline modification and usage by users;
- a list of preferences with each preference influencing contract clause and contract outline selection for each potentially affected party; and
- a contract drafting module authenticating each selection of at least one of a contract clause from the contract clauses table and a contract outline from the contract outlines table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties.

Horwitz '866 discloses authenticated content selection (Horwitz '866: Abstract).

Additionally, Horwitz '866 discloses:

- a set of searchable indices of the contract clauses table and the contract outlines table using a topical ordering (Horwitz '866: Fig. 4A, item 90, "Matter_ID" key field - note that as combined with Shirley '206, each matter corresponds to a clause, each of which has its own topic);

- a list of authorizations with each authorization controlling contract clause and contract outline modification and usage by users (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person");
- a list of preferences with each preference influencing contract clause and contract outline selection for each potentially affected party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person"); and
- a contract drafting module authenticating each selection of at least one of a contract clause from the contract clauses table and a contract outline from the contract outlines table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43).

It would have been obvious to a person having ordinary skill in the art to apply the cross checking database of Horwitz '866 to the legal document generation means of Shirley '206 by creating an entry in the matter table of Horwitz '866 (Horwitz '866: Fig. 4A, item 90 labeled "Matter"). The motivation to combine is on the same basis as Claim 1 (supra).

Claim 34:

Regarding Claim 34, Shirley '206 discloses: an automated method for drafting a contract (Shirley '206: col. 2, lns. 8-10). Additionally, Shirley '206 discloses:

- maintaining a database shareable by a plurality of users, comprising:

- compiling a table of contract clauses, each contract clause relating to one or more parties potentially affected by a use of the contract clause and including annotations explaining the content thereof (Shirley '206: col. 5, Ins. 22-46);
- compiling a table of contract outlines, each outline creating an organizational framework into which the clauses can be inserted to form the contract and including annotations explaining the content thereof (Shirley '206: col. 2, Ins. 10-18);

However, Shirley '206 does not explicitly disclose authenticated content selection.

Additionally, Shirley '206 does not explicitly disclose:

- forming a set of searchable indices of the contract clauses table and the contract outlines table using a topical ordering;
- storing a list of authorizations with each authorization controlling contract clause and contract outline modification and usage by users;
- storing a list of preferences with each preference influencing contract clause and contract outline selection for each potentially affected party; and
- authenticating each selection of at least one of a contract clause from the contract clauses table and a contract outline from the contract outlines table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties.

Horwitz '866 discloses authenticated content selection (Horwitz '866: Abstract).

Additionally, Horwitz '866 discloses:

- forming a set of searchable indices of the contract clauses table and the contract outlines table using a topical ordering (Horwitz '866: Fig. 4A, item 90, "Matter_ID" key field - note that as combined with Shirley '206, each matter corresponds to a clause, each of which has its own topic);
- storing a list of authorizations with each authorization controlling contract clause and contract outline modification and usage by users (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person");
- storing a list of preferences with each preference influencing contract clause and contract outline selection for each potentially affected party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person"); and
- authenticating each selection of at least one of a contract clause from the contract clauses table and a contract outline from the contract outlines table against the authorizations list for a given user and the preferences list for the given user and the potentially affected parties (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43).

It would have been obvious to a person having ordinary skill in the art to apply the cross checking database of Horwitz '866 to the legal document generation means of Shirley '206 by creating an entry in the matter table of Horwitz '866 (Horwitz '866: Fig. 4A, item 90 labeled "Matter"). The motivation to combine is on the same basis as Claim 1 (*supra*).

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4. Claims 6-7 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirley '206 and Horwitz '866, in view of U.S. Patent No. 5,553,216 issued to Yoshioka et al. (hereafter Yoshioka '216).

Claims 6-7:

Regarding Claims 6-7, Shirley '206 and Horwitz '866 in combination disclose all the limitations of Claim 1 (supra). Additionally, Shirley '206 and Horwitz '866 in combination disclose:

- (Claim 6) further comprising: a table of topics stored into the database with each topic providing a description of a topic relating to an aspect of document drafting.

However, Shirley '206 and Horwitz '866 in combination do not explicitly disclose:

- (Claim 6) further comprising: a learn module presenting each topic upon selection.
- (Claim 7) further comprising: a journal recording each selection of an individual clause from the individual clauses table that results in a final document.

Yoshioka '216 discloses a compound document partitioning and editing means.

Specifically, Yoshioka '216 discloses:

- (Claim 6) further comprising: a learn module presenting each topic upon selection (Yoshioka '216: col. 5, lns. 25-52 - note that as combined with Shirley '206 and Horwitz '866, each section reads on a topic; further note a load operation reads on a learn module).

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- (Claim 7) further comprising: a journal recording each selection of an individual clause from the individual clauses table that results in a final document (Yoshioka '216: col. 13, Ins. 41-45 – note the history table).

It would have been obvious to a person having ordinary skill in the art to add the compound document and partitioning and editing means of Yoshioka '216 to the legal documents in the Shirley '206 and Horwitz '866 combination. The motivation to combine is suggested by Yoshioka '216 which discloses a particularly fast and advantageous way to retrieve structured documents from a database such as the legal documents of Shirley '206 and Horwitz '866 in combination (Yoshioka '216: col. 2, Ins. 13-31).

Claims 14-15:

Regarding Claims 14-15, Shirley '206 and Horwitz '866 in combination disclose all the limitations of Claim 9 (supra). Additionally, Shirley '206 and Horwitz '866 in combination disclose:

- (Claim 14) further comprising: storing a table of topics into the database with each topic providing a description of a topic relating to an aspect of document drafting.

However, Shirley '206 and Horwitz '866 in combination do not explicitly disclose:

- (Claim 14) further comprising: presenting each topic upon selection.
- (Claim 15) further comprising: recording each selection of an individual clause from the individual clauses table that results in a final document into a journal.

Yoshioka '216 discloses a compound document partitioning and editing means.

Specifically, Yoshioka '216 discloses:

- (Claim 14) further comprising: presenting each topic upon selection (Yoshioka '216: col. 5, Ins. 25-52 - note that as combined with Shirley '206 and Horwitz '866, each section reads on a topic; further note a load operation reads on a learn module).
- (Claim 15) further comprising: recording each selection of an individual clause from the individual clauses table that results in a final document into a journal (Yoshioka '216: col. 13, Ins. 41-45 – note the history table).

It would have been obvious to a person having ordinary skill in the art to add the compound document and partitioning and editing means of Yoshioka '216 to the legal documents in the Shirley '206 and Horwitz '866 combination. The motivation to combine is on the same basis as Claims 6-7 (*supra*).

5. Claims 18-19, 21-22, 24-26, 28-29, and 31-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirley '206, in view of Horwitz '866, further in view of U.S. Patent No. 6,202,066 issued to Barkley et al. (hereafter Barkley '066).

Claim 18:

Regarding Claim 18, Shirley '206 discloses a means to generate legal documents. Specifically, Shirley '206 discloses: a system for efficiently drafting a legal document (Shirley '206: col. 2, Ins. 8-10) and further discloses:

- a table of clauses compiled into a shareable database (Shirley '206: col. 5, Ins. 22-46).

However, Shirley '206 does not explicitly disclose: using an authenticated clause table.

Additionally, Shirley '206 does not explicitly disclose:

- the table of clauses where each clause relating to one or more individual parties potentially affected by a use of the clause in a legal document and including authorizations controlling access and preferences specifying provisions and terms for a specific subject matter;
- a searchable index of the clauses table formed using a topical ordering based on the specific subject matter included in the provisions and terms of each clause; and
- a clause selection interface including document drafting controls, comprising:
 - o an index panel presenting the clauses table index on the user interface; and
 - o a clause panel authenticating a clause selection against the authorizations for a given user and the preferences for the individual parties and displaying an individual clause from the clauses table on the user interface upon the selection by the given user following successful authentication.

Horwitz '866 discloses an organizational cross checking database for legal organizations. Specifically Horwitz '866 discloses using an authenticated clause table (Horwitz '866: Abstract). Additionally, Horwitz '866 discloses:

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- the table of clauses where each clause relating to one or more individual parties potentially affected by a use of the clause in a legal document and including authorizations controlling access (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person" – note connection to item 90 labeled "Matter") and preferences specifying provisions and terms for a specific subject matter (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person" – note that restricting clauses and matters reads on a preference that influences selection);
- a searchable index of the clauses table formed using a topical ordering based on the specific subject matter included in the provisions and terms of each clause (Horwitz '866: Fig. 4A, item 90, "Matter_ID" key field - note that as combined with Shirley '206, each matter corresponds to a clause, each of which has its own topic); and
- a clause selection module (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43).

However, Horwitz '866 does not explicitly disclose:

- the clause selection module is an interface including document drafting controls, comprising:
 - o an index panel presenting the clauses table index on the user interface; and
 - o a clause panel authenticating a clause selection against the authorizations for a given user and the preferences for the individual parties and displaying an individual clause from the clauses table on the user interface upon the selection by the given user following successful authentication.

Barkley '066 discloses a user interface to associate permissions. Specifically, Barkley '066 discloses:

- the clause selection module is an interface including document drafting controls, comprising:
 - o an index panel presenting the clauses table index on the user interface (Barkley '066: Figs. 2 and 3); and
 - o a clause panel authenticating a clause selection against the authorizations for a given user and the preferences for the individual parties and displaying an individual clause from the clauses table on the user interface upon the selection by the given user following successful authentication (Barkley '066: Figs. 2 and 3).

It would have been obvious to a person having ordinary skill in the art to apply the cross checking database of Horwitz '866 to the legal document generation means of Shirley '206. The motivation to combine is on the same basis as Claim 1 (*supra*).

It would have been further obvious to a person having ordinary skill in the art to apply the user interface techniques for permission granting of Barkley '066 to the Shirley '206 and Horwitz '866 combination. The motivation to combine is suggested by Barkley '066 which discloses the advantage having an administrative tool to provide instant verification that privileges have been set, such as in the authentication in the Shirley '206 and Horwitz '866 combination (Barkley '066: col. 5, Ins. 28-48).

Claims 19 and 24:

Regarding Claims 19 and 24, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose all the limitations of Claim 18 (*supra*). Additionally, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose:

- (Claim 19) further comprising:
 - o a table of outlines compiled into the shareable database, each outline creating an organizational framework into which the clauses can be inserted to form the legal document (Shirley '206: col. 2, lns. 10-18 - note standard contract documents read on standard outlines) and including authorizations controlling access (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person" – note connection to item 90 labeled "Matter") and preferences influencing outline selection for each individual party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person" – note that restricting clauses and matters reads on a preference that influences selection);
 - o a searchable index of the outlines table formed using a topical ordering based on a subject matter of each outline (Horwitz '866: Fig. 4A, item 90, "Matter_ID" key field - note that as combined with Shirley '206, each matter corresponds to a clause, each of which has its own topic); and
 - o an outline selection interface including document drafting controls, comprising:
 - an index panel authenticating the index panel against the authorizations for a given user and the preferences for the

- individual parties and presenting the outlines table index on the user interface (Barkley '066: Figs. 2 and 3); and
 - an outline panel authenticating an outline selection against the authorizations for a given user and the preferences for the individual parties and displaying an individual outline from the outlines table on the user interface upon the selection by the given user following successful authentication (Barkley '066: Figs. 2 and 3).
- (Claim 24) further comprising:
- a table of topics compiled into the shareable database, each topic providing a description of a topic relating to an aspect of document drafting (Horwitz '866: Fig. 4A, item 90 labeled "Matter" – note that in combination with Shirley '206, each clause is mapped to a matter) and including authorizations controlling access (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person" – note connection to item 90 labeled "Matter") and preferences influencing topic selection for each individual party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person" – note that restricting clauses and matters reads on a preference that influences selection);
 - a searchable index of the topics table formed using a topical of ordering based on a subject matter of each topic (Horwitz '866: Fig. 4A, item 90,

- “Matter_ID” key field - note that as combined with Shirley ‘206, each matter corresponds to a clause, each of which has its own topic); and
- a topic selection interface including topic viewing controls, comprising:
 - an index panel presenting the topics table index on the user interface (Barkley ‘066: Figs. 2 and 3); and
 - an annotation panel authenticating a topic selection against the authorizations for a given user and the preferences for the individual parties and displaying an individual topic from the topics table on the user interface upon the selection by the given user following successful authentication (Barkley ‘066: Figs. 2 and 3).

Claim 21:

Regarding Claim 21, Shirley ‘206, Horwitz ‘866, and Barkley ‘066 in combination disclose all the limitations of Claim 19 (supra). Additionally, Shirley ‘206, Horwitz ‘866, and Barkley ‘066 in combination disclose: further comprising:

- an annotation associated with each individual clause from the clauses table and with each individual outline from the outlines table, the annotation providing an explanatory description of at least one of the associated individual clause and the associated individual outline (Horwitz ‘066: Fig. 4B, Item 94 labeled “Assignment Role” and Item 96 labeled “Assignment Type”); and
- an annotation panel presenting each annotation upon the selection of at least one of the associated individual clause and the associated individual outline (Barkley ‘066: Figs. 2 and 3).

Claim 22:

Regarding Claim 22, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose all the limitations of Claim 21 (supra). Additionally, Examiner takes Official Notice that it is well-known and notorious that an application may receive additional information via a browser accessing a hyperlink. Specifically: further comprising:

- a hyperlink to a data source external to the shareable database incorporated into one or more of the annotations, the external data source providing a further explanatory explanation of an aspect of the annotation; and
- a browser window presenting each external data source upon the selection of the hyperlink from the one or more of the annotations.

It would have been obvious to a person having ordinary skill in the art to apply the hyperlink to external information to the Shirley '206, Horwitz '866, and Barkley '066 combination. The motivation to combine is on the basis that outside information, created and maintained outside of the application may be readily incorporated into the that application.

Claim 25:

Regarding Claim 25, Shirley '206 discloses a means to generate legal documents. Specifically, Shirley '206 discloses: a method for efficiently drafting a legal document, comprising:

- compiling a table of clauses into a shareable database (Shirley '206: col. 5, Ins. 22-46).

However, Shirley '206 does not explicitly disclose: using an authenticated clause table.

Additionally, Shirley '206 does not explicitly disclose:

- the table of clauses where each clause relating to one or more individual parties potentially affected by a use of the clause in a legal document and including authorizations controlling access and preferences specifying provisions and terms for a specific subject matter;
- forming a searchable index of the clauses table using a topical ordering based on the specific subject matter included in the provisions and terms of each clause; and
- exporting a clause selection interface including document drafting controls, comprising:
 - o authenticating the clauses table index against the authorizations for a given user and the preferences for the individual parties;
 - o presenting the clauses table index on the user interface;
 - o authenticating a clause selection against the authorizations for a given user and the preferences for the individual parties; and
 - o displaying an individual clause from the clauses table on the user interface upon the selection by the given user following successful authentication.

Horwitz '866 discloses an organizational cross checking database for legal organizations. Specifically Horwitz '866 discloses using an authenticated clause table (Horwitz '866: Abstract). Additionally, Horwitz '866 discloses:

- the table of clauses where each clause relating to one or more individual parties potentially affected by a use of the clause in a legal document and including authorizations controlling access (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person" – note connection to item 90 labeled "Matter") and preferences specifying provisions and terms for a specific subject matter (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person" – note that restricting clauses and matters reads on a preference that influences selection);
- forming a searchable index of the clauses table using a topical ordering based on the specific subject matter included in the provisions and terms of each clause (Horwitz '866: Fig. 4A, item 90, "Matter_ID" key field - note that as combined with Shirley '206, each matter corresponds to a clause, each of which has its own topic); and
- exporting a clause selection module where:
 - o authenticating the clauses table index against the authorizations for a given user and the preferences for the individual parties (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43); and
 - o authenticating a clause selection against the authorizations for a given user and the preferences for the individual parties (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43).

However, Horwitz '866 does not explicitly disclose that the clause selection module includes:

- a user interface including document drafting controls, comprising:

- authenticating the clauses table index against the authorizations for a given user and the preferences for the individual parties;
- presenting the clauses table index on the user interface;
- authenticating a clause selection against the authorizations for a given user and the preferences for the individual parties; and
- displaying an individual clause from the clauses table on the user interface upon the selection by the given user following successful authentication.

Barkley '066 discloses a user interface to associate permissions. Specifically, Barkley '066 discloses:

- a user interface including document drafting controls, comprising:
 - presenting the clauses table index on the user interface (Barkley '066: Figs. 2 and 3); and
 - displaying an individual clause from the clauses table on the user interface upon the selection by the given user following successful authentication (Barkley '066: Figs. 2 and 3).

It would have been obvious to a person having ordinary skill in the art to apply the cross checking database of Horwitz '866 to the legal document generation means of Shirley '206. The motivation to combine is on the same basis as Claim 1 (*supra*).

It would have been further obvious to a person having ordinary skill in the art to apply the user interface techniques for permission granting of Barkley '066 to the Shirley '206 and Horwitz '866 combination. The motivation to combine is on the same basis as Claim 18 (*supra*).

Claims 26 and 31-32:

Regarding Claims 26 and 31-32, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose all the limitations of Claim 25 (supra). Additionally, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose:

- (Claim 26) further comprising:
 - o compiling a table of outlines into the shareable database, each outline creating an organizational framework into which the clauses can be inserted to form the legal document (Shirley '206: col. 2, lns. 10-18 - note standard contract documents read on standard outlines) and including authorizations controlling access (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person" – note connection to item 90 labeled "Matter") and preferences influencing outline selection for each individual party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person" – note that restricting clauses and matters reads on a preference that influences selection);
 - o forming a searchable index of the outlines table using a topical ordering based on a subject matter of each outline (Horwitz '866: Fig. 4A, item 90, "Matter_ID" key field - note that as combined with Shirley '206, each matter corresponds to a clause, each of which has its own topic); and
 - o exporting a outline selection interface including document drafting controls, comprising: presenting the outlines table index on the user interface (Barkley '066: Figs. 2 and 3);

- authenticating an outline selection against the authorizations for a given user and the preferences for the individual parties (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43); and
 - displaying an individual outline from the outlines table on the user interface upon the selection by the given user following successful authentication (Barkley '066: Figs. 2 and 3).
- (Claim 31) further comprising:
- compiling a table of topics into the shareable database, each topic providing a description of a topic relating to an aspect of document drafting Fig. 4A, item 90 labeled "Matter" – note that in combination with Shirley '206, each clause is mapped to a matter) and including authorizations controlling access (Horwitz '866: Fig. 4B, item 92 labeled "Assigned Person" – note connection to item 90 labeled "Matter") and preferences influencing topic selection for each individual party (Horwitz '866: Fig. 4B, item 128 labeled "Restricted Person" – note that restricting clauses and matters reads on a preference that influences selection);
 - forming a searchable index of the topics table using a topical ordering based on a subject matter of each topic (Horwitz '866: Fig. 4A, item 90, "Matter_ID" key field - note that as combined with Shirley '206, each matter corresponds to a clause, each of which has its own topic); and
 - exporting a topic selection interface including topic viewing controls, comprising:

- presenting the topics table index on the user interface (Barkley '066: Figs. 2 and 3);
 - authenticating an topic selection against the authorizations for a given user and the preferences for the individual parties (Horwitz '866: col. 18, ln. 63 to col. 19, ln. 43); and
 - displaying an individual topic from the topics table on the user interface upon the selection by the given user following successful authentication (Barkley '066: Figs. 2 and 3).
- (Claim 32) a computer-readable storage medium holding code for performing the method of Claim 25 (Horwitz '866: col. 25, ln. 60 to col. 26, ln. 24).

Claim 28:

Regarding Claim 28, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose all the limitations of Claim 26 (supra). Additionally, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose: further comprising:

- associating an annotation with each individual clause from the clauses table and with each individual outline from the outlines table, the annotation providing an explanatory description of at least one of the associated individual clause and the associated individual outline (Horwitz '066: Fig. 4B, Item 94 labeled "Assignment Role" and Item 96 labeled "Assignment Type"); and
- presenting each annotation upon the selection of at least one of the associated individual clause and the associated individual outline (Barkley '066: Figs. 2 and 3).

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Claim 29:

Regarding Claim 29, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose all the limitations of Claim 28 (supra). Additionally, Examiner takes Official Notice that it is well-known and notorious that an application may receive additional information via a browser accessing a hyperlink. Specifically: further comprising:

- incorporating a hyperlink to a data source external to the shareable database into one or more of the annotations, the external data source providing a further explanatory explanation of an aspect of the annotation; and
- presenting each external data source upon the selection of the hyperlink from the one or more of the annotations.

It would have been obvious to a person having ordinary skill in the art to apply the hyperlink to external information to the Shirley '206, Horwitz '866, and Barkley '066 combination. The motivation to combine is on the same basis as Claim 22 (supra).

6. Claims 20, 23, 27, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirley '206, Horwitz '866, and Barkley '066, in view of Yoshioka '216.

Claim 20:

Regarding Claim 20, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose all the limitations of Claim 19 (supra). However, Shirley '206, Horwitz '866, and Barkley '066 in combination do not explicitly disclose: further comprising:

- a hierarchical tree display of at least one of the outlines table index and the clauses table index, each such hierarchical tree display comprising:
 - o a general topic listing comprising one or more of general index entries from the at least one of the outlines table index and the clauses table index; and
 - o a specific topic listing comprising one or more of specific index entries from the at least one of the outlines table index and the clauses table index.

Yoshioka '216 discloses:

- a hierarchical tree display of at least one of the outlines table index and the clauses table index, each such hierarchical tree display comprising:
 - o a general topic listing comprising one or more of general index entries from the at least one of the outlines table index and the clauses table index (Yoshioka '216: col. 13, Ins. 1-24; Fig. 6 – note that as combined with Shirley '206, headers for clauses correspond to topics); and
 - o a specific topic listing comprising one or more of specific index entries from the at least one of the outlines table index and the clauses table index (Yoshioka '216: col. 13, Ins. 1-24; Fig. 6 – note that as combined with Shirley '206, headers for clauses correspond to topics).

It would have been obvious to a person having ordinary skill in the art to apply the hierarchy of Yoshioka '261 to the Shirley '206, Horwitz '866, and Barkley '066 combination. The motivation to combine is suggested by Yoshioka '216 which discloses

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a particularly fast and advantageous way to retrieve structured documents from a database such as the legal documents of Shirley '206, Horwitz '866, and Barkley '066 in combination (Yoshioka '216: col. 2, Ins. 13-31).

Claim 23:

Regarding Claim 23, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose all the limitations of Claim 19 (supra). However, Shirley '206, Horwitz '866, and Barkley '066 in combination do not explicitly disclose: further comprising: a journal recording each selection of at least one of the selected individual clause and the selected individual outline usage.

Yoshioka '216 discloses: further comprising: a journal recording each selection of at least one of the selected individual clause and the selected individual outline usage (Yoshioka '216: col. 13, Ins. 41-45 – note the history table).

It would have been obvious to a person having ordinary skill in the art to add the compound document and partitioning and editing means of Yoshioka '216 to the legal documents in the Shirley '206, Horwitz '866, and Barkley '066 combination. The motivation to combine is suggested by Yoshioka '216 which discloses a particularly fast and advantageous way to retrieve structured documents from a database such as the legal documents of Shirley '206, Horwitz '866, and Barkley '066 in combination (Yoshioka '216: col. 2, Ins. 13-31).

Claim 27:

Regarding Claim 27, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose all the limitations of Claim 26 (*supra*). However, Shirley '206, Horwitz '866, and Barkley '066 in combination do not explicitly disclose: further comprising:

- building a hierarchical tree display of at least one of the outlines table index and the clauses table index, each such hierarchical tree display comprising:
 - o a general topic listing comprising one or more of general index entries from the at least one of the outlines table index and the clauses table index; and
 - o a specific topic listing comprising one or more of specific index entries from the at least one of the outlines table index and the clauses table index.

Yoshioka '216 discloses:

- building a hierarchical tree display of at least one of the outlines table index and the clauses table index, each such hierarchical tree display comprising:
 - o a general topic listing comprising one or more of general index entries from the at least one of the outlines table index and the clauses table index (Yoshioka '216: col. 13, Ins. 1-24; Fig. 6 – note that as combined with Shirley '206, headers for clauses correspond to topics); and
 - o a specific topic listing comprising one or more of specific index entries from the at least one of the outlines table index and the clauses table index (Yoshioka '216: col. 13, Ins. 1-24; Fig. 6 – note that as combined with Shirley '206, headers for clauses correspond to topics).

It would have been obvious to a person having ordinary skill in the art to apply the hierarchy of Yoshioka '261 to the Shirley '206, Horwitz '866, and Barkley '066 combination. The motivation to combine is on the same basis as Claim 20 (supra).

Claim 30:

Regarding Claim 30, Shirley '206, Horwitz '866, and Barkley '066 in combination disclose all the limitations of Claim 26 (supra). However, Shirley '206, Horwitz '866, and Barkley '066 in combination do not explicitly disclose: further comprising: recording each selection of at least one of the selected individual clause and the selected individual outline usage in a journal.

Yoshioka '216 discloses: further comprising: recording each selection of at least one of the selected individual clause and the selected individual outline usage in a journal (Yoshioka '216: col. 13, lns. 41-45 – note the history table).

It would have been obvious to a person having ordinary skill in the art to add the compound document and partitioning and editing means of Yoshioka '216 to the legal documents in the Shirley '206, Horwitz '866, and Barkley '066 combination. The motivation to combine is on the same basis as Claim 23 (supra).

Response to Arguments

7. Applicants' arguments filed 24 August 2005 have been fully considered but they are not persuasive.

Referring to applicants' remarks on pages 13-15 regarding the Section 103 rejections of claims 1-5, 8-13, 16-17, and 33-34 (Shirley in view of Horwitz): Applicants argued that there is no suggestion or motivation to modify or combine the references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation to combine comes from the references themselves AND the knowledge generally available to one of ordinary skill in the art.

Shirley is directed to contract generation, while Horwitz is directed to conflict resolution of relationships. The generation of a contract is a legal binding that creates a relationship between the two parties bound by the contract. Horwitz provides explicit motivation for the combination in the disclosure of col. 2, ln. 61 to col. 3, ln. 18, which shows that Horwitz's conflict resolution functionality is useful for detecting conflicts prior to parties entering into a relationship (i.e. prior to generating a contract). Thus, one of ordinary skill in the art at the time the invention was made would have been properly motivated, at least by this disclosure in Horwitz, to combine the two teachings to provide Horwitz's conflict resolution functionality to resolve potential conflicts prior to

employment of Shirley's contract generation to generate a contractual relationship between parties.

Referring to applicants' remarks on pages 15-16 regarding the Section 103 rejections of claims 1-5, 8-13, 16-17, and 33-34 (Shirley in view of Horwitz): Applicants argued that there is no reasonable expectation of success in combining the references.

The examiner disagrees for the following reasons: Applicants' argument that "Combining the teachings of Shirley with the teachings of Horwitz would... fail to provide flexibility useful in a greater variety of situations than would otherwise be provided by Shirley" (response, page 16) is speculative, and has no factual support in either Shirley or Horwitz. Shirley does not contemplate conflict resolution, as disclosed in Horwitz. The terms "conflict" and "resolution" are completely absent from the Shirley reference, as is any allusion to the overall concept of conflict resolution. Thus, as shown above, one of ordinary skill in the art at the time the invention was made would have been motivated, and have a reasonable expectation of success, to combine Horwitz and Shirley so as to provide conflict resolution prior to the generation of a contract to avoid any potential conflicts.

Referring to applicants' remarks on pages 16-17 regarding the Section 103 rejections of claims 1-5, 8-13, 16-17, and 33-34 (Shirley in view of Horwitz): Applicants argued that the combined references fail to teach or suggest all the claim limitations.

The examiner disagrees for the following reasons: Applicants' argument that "The Shirley-Horwitz combination fails to teach or suggest such limitations and instead teaches and suggests associating persons to individual matters or cases by *role*..."

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(response, page 17) is an improper summation of the reference teachings, failing to consider the particular teachings cited in the grounds for rejection. Namely, Horwitz's user preferences are equivalent to the claimed "clauses" as specified in the grounds for rejection of exemplary independent claim 1. Thus, the combination does teach each and every limitation of claims 1-5, 8-13, 16-17, and 33-34.

The remainder of applicants' remarks directed to all other pending claims substantially repeat one or more of the arguments addressed above. Therefore, the examiner's responses above are believed to address these remaining arguments as well.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goddard whose telephone number is 571-272-4020. The examiner can normally be reached on M-F, 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 571-272-4023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bdg
17 November 2005


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